

Appl. No.: 10/030,679  
Filed: January 11, 2002  
Page 10

---

### **REMARKS/ARGUMENTS**

In view of the following remarks, reexamination and reconsideration of this application, withdrawal of the rejections, and formal notification of the allowability of all claims as presented are earnestly solicited in light of the remarks that follow. Claims 33-52 are pending. In response to the Office Action, Claims 33, 46, 49, and 50 have been amended and Claims 34 and 47 have been cancelled. The amendments to the claims find support throughout the Specification and the Drawings and no new matter has been added. Accordingly, it is believed that the claims now define patentable subject matter over the prior art cited by the Examiner and notice to such effect is requested at the Examiner's earliest convenience.

### **Objections to the Drawings**

The drawings were objected to in the Office Action for various reasons. The Applicant respectfully traverses these objections and requests withdrawal of the same.

With respect to the downwardly directed flange of 23B, such a feature is clearly shown in FIG. 10 as reference number 32 and specifically addressed on Page 15, lines 11-16 of the Specification, where reference number 32 is described as a downwardly opening broad channel formed from the spine 24 of the reinforcement section 23B. In this regard, the Applicant submits that reference numbers 23B and 24 in FIG. 12 are not referring to the same part, wherein this distinction is supported within the Specification, such as on Page 15, lines 5-16, and in the Figures, as shown in greater detail, for example, in FIG. 10.

With respect to reference number 32 and the cross member 27, the Applicant notes that reference number 32, as discussed, refers to a downwardly directed flange of the reinforcement section 23B, while the cross member 27 includes an upwardly directed flange 33, as shown in FIGS. 10 and 11 and described, for example, on Page 15, lines 11-21 of the Specification. As such, the interaction between the downward flange 32 of the reinforcement section 23B and the upward flange 33 of the cross member 27 is clearly shown in FIG. 11.

Appl. No.: 10/030,679  
Filed: January 11, 2002  
Page 11

---

With respect to the relief element noted in the Office Action, the Applicant further submits that such a relief element is indicated, for example, as reference number 46A in FIG. 16 and particularly described as such, for example, on Page 17, lines 24-31 of the Specification.

Accordingly, the Applicant respectfully notes that the drawing objections in the Office Action are moot in light of the above explanations and drawing corrections are not necessary. Thus, the Applicant requests withdrawal of these objections.

### **Objections to the Specification**

The Specification was objected to in the Office Action for various informalities. In response, the Specification has been amended, as noted above, to address these objections in full.

### **Claim Rejections – 35 U.S.C. § 112**

Claims 33-52 were rejected in the Office Action as being indefinite for various reasons. In response, Claims 33, 46, 49, and 50 have been amended and Claims 34 and 47 have been cancelled. More particularly, Claims 33 and 50 have been amended to indicate that the reinforcement means has a portion embedded within the slab and extends outwardly thereof so as to form an outwardly accessible portion, wherein the portion embedded within the slab is configured to extend through the slab, away from the visible face, and then outwardly of the other face of the slab as the outwardly accessible portion. Such a configuration is shown in the Figures and is supported throughout the Specification. As such, the Applicant requests withdrawal of this rejection.

With respect to Claim 39, the Applicant respectfully traverses this rejection. Claim 38 claims a plurality of metal sections forming a frame arrangement and Claim 39 specifically claims a plurality of corrugated rods extending between the metal sections of the frame arrangement. Accordingly, the Applicant submits that this language clearly indicates that the corrugated rods extend between the metal sections and thus requests withdrawal of this rejection.

With respect to Claim 41, the Applicant respectfully traverses this rejection. Page 15, lines 5-10 of the Specification discloses that "some of the cross members of the reinforcement sections 23 B of the façade panels may have the spines 24 confronting and touching the spines

Appl. No.: 10/030,679  
Filed: January 11, 2002  
Page 12

---

28 of the cross member sections 27 of the lattice structure 25," as shown in FIGS. 11 and 13. Accordingly, the Applicant submits that Claim 41 is consistent with the disclosure and thus requests withdrawal of this rejection.

Claim 49 has been amended to indicate that an insert is configured as a relief element, and the insert is capable of being inserted into a receptacle defined by corresponding depressions of juxtaposed panels. The Applicant thus submits that this amendment to Claim 49 addresses the 35 U.S.C. § 112 rejection thereof set forth in the Office Action, and requests withdrawal of this rejection.

The Applicant therefore submits that the rejections under 35 U.S.C. § 112 set forth in the Office Action have been fully considered and addressed.

#### **Claim Rejections – 35 U.S.C. § 102**

Claims 33, 35, and 45 were rejected in the Office Action as being anticipated by U.S. Patent No. 5,526,629 to Canvaness. In response, Claim 33 has been amended to indicate that a building façade panel comprises a slab of an air-setting resistant material and having opposed faces, wherein one of the faces comprises a visible face defining a molded pattern. Such a configuration is supported throughout the Specification and the Figures such as, for example, on Page 11, lines 24-26 of the Specification and in Figure 1. As such, no new matter has been added.

The Canvaness '629 reference discloses a composite building panel including a planar concrete slab portion at the front and a plurality of elongated frame members at the rear. The front side of each frame member is embedded in the concrete slab portion along the entire length of the frame member, and the rear end of each frame member is oriented opposite from the concrete slab portion. The frame members are all oriented on one side of the concrete slab portion to provide reinforcement, define cavities therebetween for the installation of plumbing, electrical wiring, and insulation, and to provide for the attachment of wallboard. Composite building panels are formed by attaching the frame members to one another to form a frame assembly that is suspended horizontally above a pouring pad by forms that bound the frame assembly. Uncured concrete is poured between the forms to a depth such that, along the length

Appl. No.: 10/030,679  
Filed: January 11, 2002  
Page 13

of the frame members, the first sides of the frame members are embedded in the concrete and the second sides extend from the concrete.

Accordingly, the Canvaness '629 reference does not teach that the slab includes a visible face defining a molded pattern, as specifically recited in Claim 33, as thus does not anticipate the embodiments of the present invention, as now claimed. As such, the Applicant submits that Claim 33, as well as Claims 35 and 45 which depend therefrom, are patentable over the Canvaness '629 reference.

#### Claim Rejections – 35 U.S.C. § 103

Claims 34, 36, and 50-52 were rejected in the Office Action as being unpatentable over the Canvaness '629 reference in view of U.S. Patent No. 5,715,637 to Hesterman *et al.*, while Claim 37 was rejected as being unpatentable over the Canvaness '629 reference in view of U.S. Patent No. 2,703,003 to Ruppel, and Claim 38 was rejected as being unpatentable over the Canvaness '629 reference in view of U.S. Patent No. 1,682,253 to Romero *et al.* In addition, Claims 46 and 47 were rejected as being unpatentable over the Canvaness '629 reference.

As previously discussed, Claim 33, as now claimed and upon which Claims 36-38 depend either directly or indirectly, is not anticipated by the Canvaness '629 reference. However, since the subject matter of Claim 34 was incorporated into Claim 33, the rejection of Claim 34 over the Canvaness '629 reference in view of the Hesterman '637 reference will be addressed with respect to amended Claim 33. The Hesterman '637 reference discloses a prefabricated composite building panel with improved fire retardancy, and includes a supporting plywood board, a foamed sheet of polyurethane, and a covering layer on the front face of the polyurethane. The covering layer comprises a plurality of brick slices with an aggregate in the spaces between the brick slices which is bonded into the front face of the foam. Improved fire retardancy is improved by a plurality of vertical support metal strips on the inside face of the brick slices at spaced positions across the width of the panel. Each metal strip includes a hanger element at the top which engages over a portion of the foam, and a plurality of punched tabs each of which engages under a respective one of the brick slices. Accordingly, the Hesterman '637 reference describes a layer of brick slices and aggregate bonded to the front face of the foam and

Appl. No.: 10/030,679  
Filed: January 11, 2002  
Page 14

thus does not teach, suggest, or provide motivation for a slab that includes a visible face defining a molded pattern, as specifically recited in Claim 33. As such, the Applicant submits that the Canvaness '629 and the Hesterman '637 references, either separately or in combination, do not teach, suggest, or provide motivation for a slab that includes a visible face defining a molded pattern, as now claimed in Claim 33. Therefore, Claim 33 is patentable over the Canvaness '629 and the Hesterman '637 references.

With respect to the rejections of Claims 46 and 47, Claim 46 has been amended to incorporate the subject matter of Claim 47, and Claim 47 has been cancelled. More particularly, Claim 46 has been amended to recite the step of inserting a mold into a mold arrangement, wherein the mold defines a pattern to be imparted to the slab. Thereafter, an air-setting resistant material is introduced into the mold arrangement so as to form a slab such that, upon solidification of the air-setting resistant material, one face of the slab comprises a visible face defining the molded pattern. As previously discussed with respect to Claim 33, the Canvaness '629 reference does not teach that the slab includes a visible face defining a molded pattern, as now specifically recited in Claim 33. Furthermore, the Canvaness '629 reference does not teach, suggest, or provide motivation for inserting a mold defining a pattern to be imparted to the slab into the mold arrangement prior to the slab being formed. Accordingly, the Applicant submits that the Canvaness '629 reference does not teach, suggest, or provide motivation for a method of forming a slab that includes a visible face defining a molded pattern, as now claimed in Claim 46. Therefore, Claim 46 is patentable over the Canvaness '629 reference.

With respect to the rejections of Claims 50-52, Claim 50 has been amended to indicate that one face of the slab comprises a visible face defining a molded pattern. As previously discussed, the Canvaness '629 and Hesterman '637 references, either separately or in combination, do not teach suggest, or provide motivation for a slab having a visible face defining a molded pattern. Accordingly, Claim 50, as now claimed and upon which Claims 51 and 52 depend, is patentable over the Canvaness '629 and Hesterman '637 references.

The Federal Circuit has consistently stated that a finding of obviousness requires a specific teaching, motivation, or suggestion to combine the teachings of individual items of prior art. See, e.g., *In Re Sang Su Lee*, No. 00-1158 (Fed. Cir. January 18, 2002) (factual question of

Appl. No.: 10/030,679  
Filed: January 11, 2002  
Page 15

motivation to combine is material to patentability and could not be resolved on subjective belief and unknown authority); *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352 (Fed. Cir. 1998) (a showing of a suggestion, teaching, or motivation to combine is an essential evidentiary component of an obviousness holding); *In re Fritch*, 972 F.2d 1260, 1265 (Fed. Cir. 1992) (Examiner can satisfy burden of obviousness in light of combination only by showing some objective teaching leading to the combination); and *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988) (evidence of teaching or suggestion essential to avoid hindsight). In this instance, the Canvaness '629, Hesterman '637, Ruppel '003, and Romero '253 references, either separately or in combination, do not teach, suggest, or provide motivation for the embodiments of the present invention as now claimed in Claims 33, 35-46, and 48-52. Thus, the Applicant submits that the present invention, as now claimed, is patentable over the Canvaness '629, Hesterman '637, Ruppel '003, and Romero '253 references.

### Conclusion

In summary, the Canvaness '629, Hesterman '637, Ruppel '003, and Romero '253 references, either separately or in combination, do not teach, suggest, or provide motivation for the embodiments of the present invention, as now claimed in Claims 33, 35-46, and 48-52. Accordingly, in view of these differences between the Applicants' invention and the Canvaness '629, Hesterman '637, Ruppel '003, and Romero '253 references, it is submitted that the present invention, as defined by the pending claims, is patentable over the prior art cited by the Examiner. As such, Claims 33, 35-46, and 48-52 are believed to be in condition for immediate allowance.

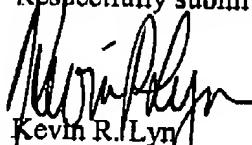
In conclusion, for the reasons set forth above, the Applicant submits that all claims now pending are in condition for immediate allowance. Accordingly, notice to such effect is respectfully requested at the Examiner's earliest opportunity.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required

Appl. No.: 10/030,679  
Filed: January 11, 2002  
Page 16

therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

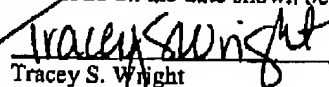
  
Kevin R. Lyn  
Registration No. 42,818

OFFICIAL

Customer No. 00826  
ALSTON & BIRD LLP  
Bank of America Plaza  
101 South Tryon Street, Suite 4000  
Charlotte, NC 28280-4000  
Tel Raleigh Office (919) 862-2200  
Fax Raleigh Office (919) 862-2260

CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the US Patent and Trademark Office at Fax No. 1-703-872-9326 on the date shown below.

  
Tracey S. Wright

8/22/03  
Date

RTA 2141650v1

FAX RECEIVED  
AUG 22 2003  
GROUP 3600